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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 92032341 |
| Party | Defendant MICHEL FARAH |
| Correspondence Address | David M. Rogero David M. Rogero, P.A. 2600 Douglas Road, Suite 600 Coral Gables, FL 33134 UNITED STATES dmrogero@dmrpa.com |
| Submission | Opposition/Response to Motion |
| Filer's Name | David M. Rogero |
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| Signature | /s/David M. Rogero/ |
| Date | 04/04/2006 |
| Attachments | Reply Motion to suspend 040406.pdf (4 pages) |

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| PRAMIL S.R.L. (ESAPHARMA), |) | Cancellation No. 92032341 |
| |) | Registration No. 2,447,970 |
| Petitioner, |) | Mark: OMIC PLUS |
| |) | |
| v. |) | |
| |) | |
| MICHEL FARAH, |) | |
| |) | |
| Registrant. |) | |
| <hr style="width: 40%; margin-left: 0;"/> |) | |

REGISTRANT’S REPLY TO PETITIONER’S RESPONSE TO
MOTION TO SUSPEND PROCEEDING

Pursuant to 37 C.F.R. § 2.117, this Board may suspend this proceeding when it is brought to its attention that “that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case.” [Emphasis added.] A copy of the complaint filed in the U.S. District Court for the Southern District of Florida, was filed with Registrant’s motion. The complaint satisfies the two requirements of the regulation.

First, the complaint alleges that the plaintiff, Gapardis Health & Beauty, Inc., known as the Mitchell Group, is the exclusive licensee of Registrant Michel Farah regarding the mark OMIC PLUS. *See* Paragraph 10 of Complaint. The Petitioner, Pramil S.R.L., is named as a party defendant, along with its U.S. distributor, International Beauty Exchange, Inc. Thus, a party to this proceeding, and distributors of the parties to this proceeding, are involved in the pending court case.

Petitioner asserts that it is unknown whether it has been served with the complaint. The undersigned is informed that service of the summons and complaint was served today, April 4,

upon the named defendant International Beauty Exchange. Further, service upon Pramil S.R.L. is in process under the provisions of the Hague Convention.

Second, the complaint alleges that the sale and distribution by the defendants, including the Petitioner here, of goods bearing the mark OMIC PLUS is an infringement of the plaintiff's trademark rights. The court's determination of the claims raised will necessarily involve a determination of the parties' rights to the mark at issue. In the event the Court determines that the Petitioner's use of this mark is an infringement, the claim of Petitioner for cancellation of the mark will be extinguished, and this proceeding will be rendered moot. Thus, the civil action may be dispositive of the issues raised in this proceeding.

Petitioner cites *Ortho Pharmaceutical Corporation v. Hudson Pharmaceutical Corporation*, 178 USPQ 429 (TTAB 1973), for the proposition that a motion to suspend filed after testimony and briefing periods is untimely. In fact, the Board in the *Ortho Pharmaceutical* matter ruled that a motion to suspend an opposition was untimely when filed after final hearing, and was based upon the ground that the applicant had ascertained that the opposer had abandoned its mark and that the applicant expected to file a cancellation petition within a few days. In this matter, there has been no final hearing, and a civil action putting at issue the rights of the parties to this mark is not merely anticipated, it has been filed and is currently pending.

Petitioner also cites *E. I. du Pont de Nemours and Company v. G. C. Murphy Company*, 199 USPQ 807 (TTAB 1978). In that matter, the parties had submitted extensive evidence and fully briefed the issues, primarily a claim that the opposer had abandoned its mark. The Board determined that it should decide the opposition on the complete record before it "for whatever benefit the court might obtain therefrom in resolving the controversy before it." By contrast, in the instant matter, the Board has rejected the evidence the Registrant has tendered, the evidence

before the Board is an incomplete version of the underlying facts, and, accordingly, the issues have not been fully presented. On the record in this matter, a decision by the Board will not provide any benefit to the District Court as it will not be based upon a full exposition of the facts.

As stated in *Kearns-Tribune, LLC v. Salt Lake Tribune Publishing Company, LLC*, 2003 TTAB LEXIS 470, *8:

Whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action, proceedings before the Board may be suspended until final determination of the civil action. *See* Trademark Rule 2.117(a); and *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992). Suspension of a Board case is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling will have a bearing on the rights of the parties in the Board case. *See Martin Beverage Co. Inc. v. Colita Beverage Company*, 169 USPQ 568, 570 (TTAB 1971). USPQ 861 (TTAB 1973).

A reading of the complaint filed in the District Court shows that the civil action will certainly have a bearing on the rights of the parties. In the interest of judicial economy and in keeping with this Board's inherent authority to regulate its own proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion, *Kearns-Tribune, LLC, supra at *10*, the Board should exercise its discretion to suspend this proceeding pending the outcome of the District Court action.

Respectfully submitted,

/s/David M. Rogero/
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Registrant's Reply to Response to Motion to Suspend Proceeding was sent by first class mail with proper postage affixed, the 4th day of April, 2006, to the following counsel for petitioner:

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/s/David M. Rogero/